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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/035,661 03/23/93 KAPLAN

J JOSH-00111

EXAMINER
WEINHARDT, R

23M1/0921

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ART UNIT	PAPER NUMBER
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2,111

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DATE MAILED: 09/21/93

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 08-4-93 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 30 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 153

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. (3) | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 14-17 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☒ Claims 1-13 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 14-17 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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1. The drawings are objected to under 37 C.F.R. § 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the magnetic, magneto-optical and floptical media, ROM, EPROM, ROM card, Flash RAM and "combination thereof" used as the information storage means must be shown or the feature cancelled from the claim. Also, the various products, product identification means and steps and user interaction means and steps recited must be shown or the features cancelled from the claim. Note claims 15-17 and 24-26 for example. No new matter should be entered.

2. The preliminary amendment filed 3-23-93 calls for the cancellation of the original claims, claims "15 through 22". As claims 1-13 are the original claims because this case is not a file wrapper continuation of parent application SN 07/957,444, claims 1-13 have been cancelled, leaving claims 14-117. Applicant should verify this in any response to this Office action.

3. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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The specification is objected to under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed.

The specification presents a preferred embodiment wherein the storage means used to store portions of the products available for sale are CD ROM discs, which are optical discs and arguably, an "audio CD" since it is an optical disc containing audio information. However, the specification does not provide specific support for the other types of media recited in the claims including the magnetic, magneto-optical and floptical media, ROM, EPROM, ROM card, Flash RAM and especially any combinations thereof. Furthermore, suitable players for these media and the corresponding controllers are not set forth. While the specification states that "other applications are possible", this does not provide specific basis for the use of these media, especially in combinations. Thus, the recitation of these media represent new matter.

Similarly, the preferred embodiment described in the specification identifies the bar code scanner and touch screen respectively as the preferred means to identify the product and interact with the system. Further, on page 10, lines 1-2, it is specifically stated that "no keyboard" is provided to avoid "levels of confusion or intimidation". Thus, the recitation of telephone keypads, voice command, etc.

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represent new matter since they are not supported nor desired by the specification as originally filed. Further, no specific support is found for the variety of manners of operation of the touch screen such as those set forth in claim 26.

Also, the specification identifies music products as the items to be previewed and provides no specific guidance on the previewing of "software", especially "program components" thereof. While music products can be considered "software", the use of this term to describe computer code is well recognized and as such, its recitation represents new matter. No specific means are identified to permit "retrieval and presentation" of the software. Further, the preview of "program components" is not clear since many times, portions of computer code cannot operate properly without the remainder of the program and since no means are specifically identified to allow the typical interaction with the program. NO JOYSTICK ETC.

With respect to the recitation of video products, again, the specification as originally filed does not provide specific basis for the preview of such products and it is not clear what "selections" from the video product represent since video products do not typically have independent portions like the songs of a music product. Similarly, the specification does not provide specific support for the preview of interactive CD-ROM products and does not give any guidance as to what such a "preview" would entail since the CD-ROM product is recited as being

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"interactive". In other words, the specification does not indicate how a user may interact with the CD-ROM that is being previewed since the interactive means disclosed is for selection and rating etc., of the music product. Also, like computer code, it is not clear what "features" and "program components" of a CD-ROM consist of since they are not typically separable. Finally, any presentation of a "demo" version of software or CD-ROM would not provide the previewing of the actual product as recited.

NO INPUT
MEANS
FOR
USER
FOR
INTERACTION

In general, the original specification does not provide the support for the presentation of the wide varieties of data products selected by the various means as is now claimed.

4. Claims 15-17, 24-25, 29, 31, 34, 36, 39 and 40-117 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Dependent claims not specifically including limitations mentioned above are rejected due to their dependence on claims that do. Further, in light of these new matter issues, prior art will not be applied against these claims in this Office action.

5. Claims 20-21, 25-26, 28, 30-32, 35-37, 40-65, 72-73, 77-78, 80, 98-99, 103, 106 are rejected under 35 U.S.C. § 112, second paragraph, as being

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indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 20-21, 46-47, 72-73, 98-99 it is not clear what an identification or selection-choice "event" is.

In claims 25, 30, 35, 51, 56, 77 it is not clear what is meant by "selecting an existing reference" since it is not clear where this reference exists or what means are used to present it to the user.

In claims 26, 78, 103, it is not clear how the steps recited relate to the "existing reference" recited in their corresponding preceding claims.

In claims 28, 54, 80, 106, it is not clear what data is being uploaded or downloaded.

In claims 40-65, it is not clear what is meant by "software". While music products can be considered a type of "software" for the players, "software" also includes computer code.

Dependent claims not specifically mentioned above are rejected because by their dependence they include the language of a rejected base claim.

6. Claims 14-117 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 5,237,157. Although the conflicting claims are not identical, they are

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not patentably distinct from each other because deletion of a feature with a corresponding loss of function has been held to be obvious.

The patented claims recite entering a subscriber code to authorize access and supplying a product code from the specific music product packaging of a product available for sale and further recite the use of bar codes and readers. The instant claims have generally deleted these features and thus, their deletion, with the corresponding loss of function makes the instant claims obvious variants of the patented claims. See *In re Porter*, 20 USPQ 298. While the patented claims do not recite software or video products or the variety of input and output means claimed, due to the lack of specific support for these recitations as mentioned above in the 112 first paragraph rejection, it appears that applicant believes these to be obvious variants of the disclosed preferred embodiment if their inclusion is not to be seen as new matter and thus claims including these recitations are also rejected under this grounds as obvious variants using this belief.

7. The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Weinhardt whose telephone number is (703) 305-9780.

Facsimile transmissions may be directed to (703) 305-9564 or 9565.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3800.

September 19, 1993


ROBERT A. WEINHARDT
PRIMARY EXAMINER
GROUP 2300